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| 10/585,048      | 06/29/2006  | Joao Jorge Bergner   | 3731                | 6190             |

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| EXAMINER |
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OMAR, AHMED H

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2838

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01/28/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/585,048             | BERGNER, JOAO JORG  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | AHMED OMAR             | 2838                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Objections*

1. Claim 1 is objected to due to lack of antecedent basis, claim 1 recites "...stored in a transport position in said first receiving area..." There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 6, 7, 11 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mather et al. (GB 2397704 A) in view of Hyodo et al. (US 6,066,938).

As per **claim 1**, Mather et al. discloses a device with a power tool case (See Fig.1) that includes at least one receiving area for a power tool (See Fig.1, Item#1, discloses a case and Description, Par.4 discloses the case is for the storage of the power tool) and a charger (See Fig.1 Item#3, ports, and Description Par.7 discloses the charging ports are power by battery chargers of known types), wherein the charger and the power tool case are designed to remain connected during a charging procedure (Description, Par.4 discloses the case is supplied with the charger as an integrated part of the case and not as a stand alone charger). Wherein said power tool is stored in a transport position in said first receiving area (See Description, Fig.1, and Description, Par.3, discloses a receiving area to store the power tool), but does not disclose said

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power tool is arranged in a second receiving area during said charging procedure in a standing position.

Hyodo et al. discloses a power tool charger wherein the power tool is arranged in a receiving area during said charging procedure in a standing position (See Fig.10. Items#20 and 1, discloses a power tool charger and a power tool in a standing position during charging).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by Mather et al. with that of Hyodo et al. such that said power tool is arranged in a second receiving area during said charging procedure in a standing position. Doing so would allow for the easy removal of the power tool from the charger using one hand while being charged and also would allow for charging of the power tool without having to disconnect the batteries (See Hyodo et al. Col.1, lines 20-45).

*The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 2**, Mather et al. in view of Hyodo et al. disclose the device as recited in Claim 1 recited above, wherein the power tool case includes installation space (See Fig.1, Item#2, charging panel) for the charger (See Fig.1 Item# 3), and the charger is designed to remain in the installation space of the power tool case during the charging procedure (Description, Par.4 discloses the case is supplied with the charger as an integrated part of the case and not as a stand alone charger). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 6**, Mather et al. in view of Hyodo et al. disclose the device as recited in Claim 1 above, wherein the charger includes a wind-up device for a power cord (See Fig.1, Item#5, retractable flex, and description, par.4 discloses the flex cord for the charger is housed inside the structure of the case with a pullout and lock and press button retraction system).

As per **claims 7**, Mather et al. in view of Hyodo et al. disclose a charger for a device as recited in claim 1 (See Mather et al., Fig.1, Item#2, discloses charging panel).

As per **claim 11**, Mather et al. in view of Hyodo et al. disclose a power tool case for a device as recited in claim 1 (See Mather et al. Fig.1, Item#1, discloses a power tool case).

As per **claim 20**, Mather et al. in view of Hyodo et al. disclose the device as recited in claim 6, wherein said wind-up device comprises a rotatably supported storage means located underneath a receiving area of the charger (See Mather et al. Fig.1, Item#5 and 2, discloses a retractable flex cord housed underneath the receiving area of the charger).

4. Claims **1, 3, 4, 5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrus, IV et al. (US 6,571,949) in view of Hyodo et al. (US 6,066,938).

As per **claim 1** Burrus, IV et al. discloses a device with a power tool case (See Fig.2, Item#100, case) that includes at least one receiving area (See Fig.2, Item#101, power tool receiving area) for a power tool (See Fig.1, Item#104) and a charger (See Fig.1, Items#

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101,102,103; 3 charging compartments, and Par.19, discloses the compartments include charging circuitry), wherein the charger and the power tool case are designed to remain connected during a charging procedure (See. Par.19 and 20; discloses the electrical connector in the power tool case delivers electrical power to the charging circuitry within the compartment 101 in Fig.2), wherein said power tool is stored in a transport position in said first receiving area (See Fig.2, Item#101 and 104, discloses a power tool and a receiving area for receiving the power tool), but does not disclose said power tool is arranged in a second receiving area during said charging procedure in a standing position.

Hyodo et al. discloses a power tool charger wherein the power tool is arranged in a receiving area during said charging procedure in a standing position (See Fig.10. Items#20 and 1, discloses a power tool charger and a power tool in a standing position during charging).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by Burrus, IV et al. with that of Hyodo et al. such that said power tool is arranged in a second receiving area during said charging procedure in a standing position. Doing so would allow for the easy removal of the power tool from the charger using one hand while being charged (See Hyodo et al. Col.1, lines 20-45).

*The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 3**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in claim 1 above, wherein the connection (See Fig.2, Item#105, electrical connector) between the charger (See Burrus, IV et al., Fig.2, Item# 101,102,103, charging compartments) and the power

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tool case (See Fig.2, Item# 100) is designed to be detachable (See Burrus, IV et al., Par.23, discloses the compartments (chargers) can be fixed or removable, Par.19 discloses the compartments include charging circuitry). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 4**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in Claim 3 as discussed above, wherein the charger (See Fig.1, Item# 101,102,103) is connected with the power tool case (See Burrus, IV et al.Fig.1, Item# 100) via at least one detachable fastening means (See Burrus, IV et al., Fig.1, Item#105, connector, and Par.23, discloses that the compartments (chargers) can be fixed or removable).

As Per **claim 5**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in Claim 4 as discussed above, wherein the fastening means (See Burrus, IV et al., Fig.2, Item#105) is designed to be actuated without the use of tools (See Burrus, IV et al., Fig.2, Electrical connectors 105 snap on and off to electrical connectors within compartments 101, 102 and103). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 7**, Burrus, IV et al. in view of Hyodo et al. disclose a charger for a device as recited in claim 1 above (See Burrus, IV et al., Fig.1, Items# 101,102,103, and Par.19 discloses compartments include charging circuitry).

As per **claim 8**, Burrus, IV et al. in view of Hyodo et al. disclose discloses the charger as recited in Claim 7 as discussed above, characterized by the fact that it is designed as a stand for the power tool (See Hyodo et al., Fig.10, Items#1 and 20, discloses a charger used as a stand for the power tool).

As per **claim 9**, Burrus, IV ET al. in view of Hyodo et al. disclose the charger in claim 8 as recited above, in which the power tool (See Fig.10, Item#1) is positioned at least substantially in the machining direction (See Hyodo et al., Fig.10, Items# 1 and 20, power tool placed on the charger in the machining position).

As per **claim 10**, Burrus, IV et al. in view of Hyodo et al. disclose the charger as recited in Claim 8 above characterized by a coupling unit (See Fig.5, Item#43, positive and negative terminals on the power tool handle) that is designed to correspond with a coupling unit of a power tool unit (See Fig.2, Item#10, positive and negative electrodes on the charger) while the stand function is being performed and to at least transmit charging energy (See Col.1, lines 61-67, and Col.2, lines 1-11, disclose the electrical connection established between the first set of terminals on the power tool handle and the second set of terminals on the charger when the power tool is placed on the charger). *The Examiner interprets the term "designed to" as conveying intended use that has little or no patentable weight.*

As per **claim 12**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in claim 1 as discussed above, wherein said power tool is stored in the transport position in said



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first receiving area in a lying position (See Burrus, IV, et al. Fig.2, Items#101 and 104, discloses a power tool laced in a lying position while being transported).

As per **claim 13**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in claim 1 as discussed above, wherein said second receiving area is embodied as a stand and comprises charging contacts to transmit charging energy (See Hyodo et al. Fig.10, discloses the receiving area embodied as a stand, also see Fig.5, Item#46a, discloses contacts to transmit energy).

As per **claim 14**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in claim 1 as discussed above, wherein said power tool projects above a half of said power tool case when said power tool is arranged in the second receiving area (See Hyodo et al. Fig.10, discloses power tool projects above a half of said power tool case when said power tool is arranged in the charging area).

As per **claim 15**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in claim 14 as discussed above, wherein said power tool case is reliably prevented from being closed during said charging procedure due to the standing position of said power tool ( See Hyodo et al. Fig.10, discloses the power tool projects above a half of said power tool case when said power tool is arranged in the charging area, as a result when the case will be kept open when the power tool is kept is placed in the charging position).

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As per **claim 16**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in claim 3 as discussed above, wherein a connecting means for the connection between the charger and the power tool case is integrally mounted to said power tool case (See Burrus, IV et al. Fig.2, Item#105) but does not disclose the connection between the charger and the power tool case is embodied as a flexible flap.

However the use of a flexible flap as a connecting means is well known in the art and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by Burrus, IV et al. in view of Hyodo et al. such that the connection between the charger and the power tool case is embodied as a flexible flap. Doing so would allow for the charger to be swung out of the case for maintenance without having to be disconnected from the case (See Kajiya, US 2003/0150756 A1, Pars. 4 and 5).

As per **claims 17 and 18**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in claim 4 as discussed above, but does not disclose said fastening means is embodied as a detent element such as a latching hook.

However the use of detent elements and latching hooks as fastening means is well known in the art and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention disclosed by Burrus, IV et al. in view of Hyodo et al. such that said fastening means is embodied as a detent element such as a latching hook. Doing so would provide a secure releasable connection of the charger to the case (See Zweigle, US 6,682,361 B2, Col.1, lines 20-23 and 63-67, discloses a detent hook used to safeguard an electrical connection between plug parts so that it is not inadvertently released)

As per **claim 19**, Burrus, IV et al. in view of Hyodo et al. disclose the device as recited in claim 4 as discussed above, wherein said fastening means extends through a recess in a housing wall of said power tool case (See Burrus, IV et al., Fig.3, Item#105)

### **Response to Arguments**

Applicant's arguments filed on 11/18/2008 have been considered but were ineffective to overcome the Mather et al., Burrus, IV et al. and Hyodo et al. references. (See the rejections above).

Applicant argues that the above neither Mather et al. nor Burrus, IV et al. disclose that "... a second receiving area in which a power tool is arranged during a charging procedure in a standing position". Mather et al. and Burrus, IV et al both disclose a power tool case comprising a first receiving area wherein said power tool is stored in a transport position in a lying position. Hyodo et al. teaches a power tool charger comprising a receiving area (second receiving area) wherein the power tool is arranged in said area during charging procedure in a standing position. The combination of Mather et al. with Hyodo et al. and Burrus, IV et al. with Hyodo et al. will yield a power tool case wherein the power tool is stored in a transport position in said first receiving area, and wherein said power tool is arranged in a second receiving area during said charging procedure in a standing position. A motivation to combine Mather et al. and Burrus, IV et al. with Hyodo et al. exists such that the power tool will be easy to grip with one hand and such that no disconnection of batteries from the power tool is needed to recharge the batteries.

Applicant's amendment necessitated the new ground(s) of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A Shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE- MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED OMAR whose telephone number is (571)270-7165. The examiner can normally be reached on Monday-Thursday 06:30-16:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Akm Ullah can be reached on 571-272-2361. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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